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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,827	01/27/1999	JOHN S. HENDRICKS	033033.00013	7009

4372 7590 04/28/2011

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ART UNIT	PAPER NUMBER
2421	

NOTIFICATION DATE	DELIVERY MODE
04/28/2011	ELECTRONIC

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/237,827
Filing Date: January 27, 1999
Appellant(s): HENDRICKS ET AL.

Trupti P. Joshi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/3/2011 appealing from the Office action mailed 8/19/2010.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-31, 63 and 107-109 are rejected

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of

rejection to be reviewed on appeal.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Yoshimune et al. (U.S. Patent No. 6,438,233) published August 20, 2002

Cassorla et al. (U.S. Patent No. 5,146,552) published September 8, 1992

Kubota (U.S. Patent No. 5,506,902) published April 9, 1996

Lappington et al. (U.S. Patent No. 5,519,433) published May 21, 1996

Lovett (U.S. Patent No. 4,450,477) published May 22, 1984

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13, 18-29, 63 and 107-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimune et al. (U.S. Patent No. 6,438,233) in view of Cassorla et al. (U.S. Patent No. 5,146,552).

Referring to claim 1, Yoshimune discloses a system for transmitting and receiving text (**see Figure 49 for an electronic book system that transmits and receives electronic book text**), and displaying an indication of the text (**see display unit 66 in Figure 50**), wherein the text is transmitted in an electronic signal (**see Figure 49 for the electronic book being transmitted to terminal 55D through an electronic signal and Figure 50 for the electronic book being transmitted from book display unit 63D to display unit 66 through an electronic signal**).

Yoshimune also discloses a processor that produces an electronic signal containing a representation of textual data corresponding to one or more electronic books (**see Figure 8 for the computer 56 having a processor 81 that controls the elements of computer 56, such as the display controller 85, which generates the electronic book displayed on display unit 66 (*see Column 14, Lines 54-64*)**).

Yoshimune also discloses a transmitter, connected to the processor that transmits the electronic signal (**see Figure 8 and Column 14, Lines 54-64 for the display controller 85 connected to processor 82, which transmits the electronic book/signal to the display unit 66**).

Yoshimune also discloses a home subsystem (**see terminal 55D in Figure 49**), wherein the home subsystem includes:

a connector that receives the electronic signal (**see the bus connecting the component in Figure 8 for receiving the electronic signal from the broadcast receiving interface 87**)

means, connected to the connector, for selecting a portion of the textual data (**see book data management unit 62 in Figure 50 and the keyboard interface 88 and mouse interface 89, which receives selections from operation input unit 65 (*see Column 13, Lines 38-56*), wherein the user selects a portion of textual data (*see Figure 31 for a user selecting a portion "COMICSXX" from the "COMICS" textual data*)**), comprising means for receiving a subscriber entry indicating a title of an electronic book (**see again Figure 31 for selecting a title "COMICSXX"**), wherein the title correlates to a portion of the textual data (**see again Figure 31 for the title "COMICSXX" corresponding to a portion of the "COMICS" textual data**).

an electronic collection of electronic books (**see again book data management unit 62 and book data storage unit 61 attached to memory 64 in Figure 50**), ordered and transmitted electronically via the transmitter (**see Column 13, Lines 38-56**), wherein in response to a transmitted order, the ordered electronic book is transmitted from a remote operations center to the home subsystem and stored in the library unit of the home subsystem until a selection is received to view the electronic book (**see Column 11-18 for a transmitted order being made from a book data broadcast management unit 53 according to registered broadcast schedule and Column 13, Lines 24-37 for receiving the ordered electronic books**).

means for associating subscriber-created data with individual electronic books located in the collection of electronic books (**see Figure 53 for allowing a user to enter subscriber-created data associated with the electronic books viewed by a user on a display unit, wherein the displayed book is an electronic book selected by the user from the collection of electronic books**).

means for storing the subscriber-created data with individual electronic books (**see Figures 51-53 for entering subscriber-created data with an individual electronic book (*the Examiner notes that by entering the data on the display screen along with the displayed electronic book that both the displayed electronic book and subscriber-created data are both inherently stored in a display buffer/storage until the user accesses the transmission button to transmit the data back to the central facility/book server*)**) located in the collection of electronic books (**see again book data storage unit 61 and memory 64 where the individual electronic book is located in the collection of electronic books**).

means for receiving a subscriber-entered selection (**see Column 13, Lines 38-56 for receiving a book selection**).

a menu generator that determines and generates a particular library of the books located in the collection based on a default menu and generates a searchable menu of the electronic books in the electronic book collection (**see Column 13, Lines 41-44 for generating a book menu that contains a searchable menu of electronic books from the electronic book collection stored in memory unit 64**).

means for selecting search criteria for the searchable menu based on the subscriber-entered selection (**see Column 13, Lines 44-47 for specifying search criteria such as author name**).

a display, connected to the connector (**see display unit 66 in Figures 8 and 50**), that displays the particular library menu of books relating to the determination of the menu generator (**see Column 13, Lines 41-44 for displaying the menu generated**), and displays the subscriber-created data associated with each of the books included in the particular library menu (**see Figure 53 and Column 41, Line 55 through Column 42, Line 57 for displaying the subscriber-created data on the display unit 66**).

Yoshimune fails to teach that the subscriber-created data is stored in a header file for each of the individual electronic books.

Cassorla also discloses a means for associating subscriber-created data with individual electronic books located in the collection of electronic books and means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books in a header file for each of the individual electronic books (**see Column 5, Lines 31-50**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the data entered in Figure 53, as taught by Yoshimune, using the subscriber-created data header file storage area, as taught by Cassorla, for the purpose of providing annotations which are related to a particular location in an electronic book (**see Column 2, Lines 8-10 of Cassorla**).

Referring to claim 2, Yoshimune also discloses that the processor produces the electronic signal as a video formatted composite signal (**see Figure 6 for the electronic book data transmitted over a video formatted composite signal which is separated by the data signal separation circuit 68 after demodulating the video formatted composite signal by the channel selection and demodulation circuit 57**).

Referring to claim 3, Yoshimune also discloses that the processor produces the electronic signal as a signal to be transmitted over a telephone system (**see Figure 3A and Column 5, Lines 24-36**).

Referring to claim 4, Yoshimune also discloses displaying an electronic representation of books on a book shelf, related to the textual data (**see Figure 31**). The Examiner notes that the claim fails to state an actual graphical representation of a book on a shelf and than the claim limitation electronic representation is broad, wherein a list of books to choose from is an electronic representation of multiple books that can be selected from various locations a list/bookshelf.

Referring to claim 5, Yoshimune also discloses that the display formats the menu according to title (**see Figure 31 for displaying the books by title**).

Referring to claim 6, Yoshimune also discloses that the display comprises a microprocessor that receives an indication of a selected portion of the textual data identified by the menu, and wherein the display displays the selected portion of the textual data (**see Column 32, Line 60 through Column 33, Line 2 for selecting a comic book for display in Figure 31 and displaying the comic book in Figure 32**).

Referring to claim 7, Yoshimune also discloses that the display displays a default menu (**see Figure 31 for displaying a default category menu that allows a user to select a COMICS default category**).

Referring to claim 8, Yoshimune also discloses that the connector comprises a set top terminal (**see broadcast receiver 57 in Figure 6**) with a memory for storage of the selected textual data (**see book data storage unit 61 in Figure 6**), and the display comprises a television (**see Column 44, Lines 25-39 for receiving books over a television broadcast and Figure 4A for displaying video text at a host terminal, therefore teaching a television display**).

Referring to claim 9, Yoshimune also discloses that the display comprises a portable, hand-held viewer (**see Column 16, Lines 15-22**).

Referring to claim 10, Yoshimune also discloses that the processor comprises an encoder (**see Figure 6 for a book data display unit 63, which formats/encodes the book data into a signal displayable by the display unit 66**).

Referring to claims 11-12, Yoshimune also discloses a broadcast television transmitter or a cable television transmitter (**see Column 44, Lines 25-39 for Yoshimune transmitting television broadcasts with incorporated book data and Column 40, Line 66 through Column 41, Line 2 for transmitting over cable or broadcast medium (*UHF, VHF*)**).

Referring to claim 13, Yoshimune also discloses that the connector further comprises a cable connector, that extracts textual data from a video formatted composite signal (**see broadcast receiver 57 in Figure 6 and Column 12, Lines 34-67**).

Referring to claims 18 and 107-108, see the rejection of claim 1.

Referring to claims 19-27 and 29, see the rejection of claims 2-17.

Referring to claim 28, Yoshimune discloses using a cable television transmitter to send the textual data (**see Column 40, Line 66 through Column 41, Line 2**), but fails to teach sending the textual data without any video or using the textual data to fill an entire channel of video.

The Examiner takes Official Notice to the fact that text data can be transmitted without any video and that the text data can fill an entire channel of video.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the transmission system, as taught by Yoshimune and Cassorla, using the dedicated text channel, as stated by the Examiner's Official Notice, for the purpose of a faster and more efficient transmission and receipt of textual data requested by a user.

Referring to claims 63 and 109, see the rejection of claim 1 and further note that Yoshimune teaches that the electronic purchase order is transmitted from the library unit to the remote operations center (**see Column 43, Line 60 through Column 44, Line 2**).

Claims 14-17 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimune et al. (U.S. Patent No. 6,438,233) in view of Cassorla et al. (U.S. Patent No. 5,146,552) in further view of Kubota (U.S. Patent No. 5,506,902).

Referring to claim 14, Yoshimune and Cassorla discloses all of the limitations of claim 1, however Yoshimune fails to detail the components contained within display 66 in Figures 8 and 50, thereby failing to teach the limitations of claim 14.

Kubota discloses a display (**recorder 7, disc 8 and portable terminal 9 in Figure 1**) that comprises a library unit connected to the connector, for processing the textual data (**see recorder 7/disc8 in Figures 1 and 14**) comprising: digital logic for

screening the textual data (**see recording medium driver 43 in Figure 14**) a first memory for storing the textual data (**see recording medium (HD) 42**) and a viewer, electronically communicating with the library unit, for displaying the textual data as text (**see viewer 9 in Figure 1 which electronically communicates by placing the disc 8 into viewer 9, wherein disc 8 loaded data from recorder 7**).

Referring to claim 15, Kubota also discloses that the disc 8 (**part of the library unit**) and the viewer 9 are within a common housing (**the viewer 9 with disc 8 loaded**).

Referring to claim 16, Kubota also discloses that the viewer discloses a second memory for storing textual data received from the library unit (**see disc 8 which is placed into the viewer 9 in Figures 1 and 14**), a microprocessor, connected to the second memory, for controlling the functions of the viewer (**see Column 9, Lines 24-26 for retrieving text data from the disc 8 loaded into viewer 9, which therefore teaches a microprocessor device, otherwise the viewer 9 could not load the text data from disc 8**) and a digital display circuit, connected to the microprocessor, for creating displays (**see Figures 12a-12b and Column 10, Lines 1-9 for displaying text on the viewer 9, therefore the viewer contains a digital display circuit, otherwise the text data could not be displayed**).

Kubota fails to teach an LCD, connected to the digital display circuitry, for displaying text.

The Examiner takes Official Notice to the fact that LCD displays were well known in the art at the time the instant invention was made.

Therefore, one of ordinary skill in the art would recognized modifying the viewer, as taught by Yoshimune, Cassorla and Kubota, using an LCD screen, as stated by the Examiner's Official Notice, for the purpose of providing a clear, easy to read display screen for reading text data.

Referring to claim 17, Kubota discloses that the second memory for storing textual data comprises a removable electronic card memory **(see Figures 1 and 14 for disc 8**).

Referring to claims 30-31, see the rejection of claims 14-17.

(10) Response to Argument

B. Rejection of claims 1-3, 18-29, 63 and 107-109 under 35 U.S.C. § 103

Applicant argues that Cassorla discloses adding header information to each of the reader created annotations or storing the information of annotation locations in the control header. However, Cassorla fails to teach or suggest storing the subscriber-created data associated with individual electronic books in a header file for each of the

individual electronic books. Therefore, Applicant suggests that because the annotations files are stored separately from the electronic book file and that only a reference to the annotation file is placed in the header of the electronic book file, the above limitations are not met. The Examiner respectfully disagrees.

The Examiner notes that claim limitations "***means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books in a header file for each of the individual electronic books***" is broad and open-ended. The claim limitations are unclear if the limitations "***for each of the individual electronic books***" refers back to "***a header file***" or "***the subscriber-created data***". For example, Applicant's arguments suggest that the claim be interpreted such that the subscriber-created data be stored in a header file of the actual electronic book (**the Examiner further notes that if a comma was used the claim would read "*means for storing the subscriber-created data, associated with individual electronic books located in the collection of electronic books, in a header file for each of the individual electronic books*"**). However, the Examiner has interpreted the claim where subscriber-created data is associated with individual electronic books located in the collection of the electronic books in a header file and that the subscriber-created data is also stored for each of the individual electronic books (**the Examiner further notes that if a comma was used the claim would read "*means for storing the subscriber-created data, associated with individual electronic books located in the collection of electronic books in a header file, for each of the individual electronic books*"**). Therefore, the claims have been given a

broadest reasonable interpretation by the Examiner, where the claim limitations do not dictate the actual storage location of the subscriber-created data. Even if subscriber-created data was required to be stored in the header file of the electronic book file (**which again, as stated by the Examiner above, are not required by the claim limitations**), a reference pointer to the annotation file is still a representation of subscriber-created data stored in the header file of the electronic book file.

C. Rejection of claims 14-17 and 30-31 under 35 U.S.C. § 103

In regards to claims 14-17 and 30-31, see the Examiner's rebuttal of Applicant's arguments regarding claims 1-3, 18-29, 63 and 107-109 above.

Claims 16 and 28 rely on Official Notice and not traversed

The Examiner has relied on Official Notice for the rejection of claims 16 and 28. Although Applicant has never traversed these rejections, in order to expedite the prosecution of the instant application and for the Board consideration, the Examiner has provided the Lappington and Lovett references (**see below**).

Referring to claim 16, Kubota also discloses that the viewer discloses a second memory for storing textual data received from the library unit (**see disc 8 which is**

placed into the viewer 9 in Figures 1 and 14), a microprocessor, connected to the second memory, for controlling the functions of the viewer (**see Column 9, Lines 24-26 for retrieving text data from the disc 8 loaded into viewer 9, which therefore teaches a microprocessor device, otherwise the viewer 9 could not load the text data from disc 8**) and a digital display circuit, connected to the microprocessor, for creating displays (**see Figures 12a-12b and Column 10, Lines 1-9 for displaying text on the viewer 9, therefore the viewer contains a digital display circuit, otherwise the text data could not be displayed**).

Kubota fails to teach an LCD, connected to the digital display circuitry, for displaying text.

Lappington teaches that a viewer can include an LCD display (**see Column 18, Lines 6-10**).

Therefore, one of ordinary skill in the art would recognized modifying the viewer, as taught by Yoshimune, Cassorla and Kubota, using an LCD screen, as stated by the Examiner's Official Notice, for the purpose of providing a clear, easy to read display screen for reading text data.

Referring to claim 28, Yoshimune discloses using a cable television transmitter to send the textual data (**see Column 40, Line 66 through Column 41, Line 2**), but fails to teach sending the textual data without any video or using the textual data to fill an entire channel of video.

Lovett teaches sending textual data without any video, using the textual data to fill an entire channel of video, and using a cable television transmitter to send the textual data (**see Figure 6 and Column 5, Lines 54-55**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the transmission system, as taught by Yoshimune and Cassorla, using the dedicated text channel, as stated by the Examiner's Official Notice, for the purpose of a faster and more efficient transmission and receipt of textual data requested by a user and only providing teletext data to the viewer with no video displayed in order for the user to pay full attention to the displayed teletext (**for example if an emergency weather alert is transmitted**).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jason Salce

/Jason P Salce/

Primary Examiner, Art Unit 2421

April 21, 2011

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